AMENDMENTS TO THE DRAWINGS

Submitted herewith please find one sheet of drawings, believed to obviate the Examiner's objection. Figure 1 is labeled Prior Art.

Attachments: 1 Replacement Sheet for Figure 1.

1 annotated sheet.

REMARKS/ARGUMENTS

Claims 1, 4, 5, 13, 14, 16, 19, 20, 28, 29, 31, 41, 42, 44, 45, 53, 54, 57, 59, 60, 68, and 69 are pending in the subject application. Applicants have combined claims 2, 3, 6, and 7 into claim 1; claims 17, 18, 21, and 22 into claim 16; and claims 32 and 33 into claim 31. Applicants have cancelled or amended other claims which depend directly or indirectly from the cancelled claims.

Claims 13 and 28 contain a clarifying amendment, responsive to the Examiner's objection. The amendment clearly is unrelated to issues of patentability.

In the Office Action, the Examiner rejected claims 7, 22, 47, and 62 under 35 U.S.C. § 112, second paragraph. The foregoing amendments incorporating these claims into the independent claims from which they depend address the issues regarding this rejection, and so Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

The Examiner rejected claims 1-2, 4-6, 13-14, 16-17, 19-21, 28-29, 31-32, 41-42, 44-46, 53-54, 56-57, 59-61, and 68-69 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Publication No. US 2004/0225875 (Huang). The Examiner also rejected claims 1-7, 13-14, 16-22, 28-29, 31-33, 41-47, 53-54, 56-62, and 68-69 under 35 U.S.C. § 103(a) as unpatentable over USP 6,906,426 (Sefidvash) in view of U.S. Patent Publication No. US 2004/0030805 (Fujimori). Applicants respectfully traverse these rejections, and submit that the rejections are overcome further by the foregoing amendments to the claims. Applicants respectfully request reconsideration and allowance of the claims in view of the following arguments.

Preliminarily, Applicants note that the rejection based on Huang is moot, because claims which the Examiner did not reject based on Huang now are incorporated into the independent

claims. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw this rejection as well.

The present invention relates to an IEEE 802.3 compliant device which controls data transfer between an EEPROM and a physical layer device. Looking at Fig. 3 of the present application, an arbiter 306 controls access to shadow RAM 307 over respective bridges 303, 305. Bridge 305 connects to an MDC/MDIO system controller 301. That bridge gets priority when the system controller wants to access the shadow RAM (specification, para. 21).

The pending claims under examination recite, in method and apparatus form, the giving of priority to a system controller (recited in independent claims 1 and 16 as priority to a first bridge or first bridge means connecting volatile memory or volatile storing means and a system controller or system controlling means). In claim 1, an arbiter gives that priority. In claim 16, a means for receiving requests gives that priority. In claim 31, the system controller receives priority.

In rejecting some of the claims (claims 2-7, 13, 14), the Examiner said that Applicants did not attach significance to giving priority to the first signal path (first bridge) (Office Action, pp. 6-7, discussing the arbiter). Apparently, as a result of the Examiner's perception, the Examiner did not attribute any patentable weight to that priority.

Applicants disagree with the Examiner's position on at least two bases. First, irrespective of whether Applicants indicated in so many words that giving priority to the first signal path was significant, the alleged absence of emphasis does not deprive that language of patentable distinction. The Examiner has admitted that the prior art on which he relies for the rejection

lacks this feature. Indeed, looking at element 14 (DOM sequencer) of Sefidvash (Fig. 4) and the only mention of that element (col. 6, lines 33-35), there is no mention of priority. Neither is there mention of priority in Huang or Fujimori, either.

That Applicants chose to recite the feature in the first place indicates the importance to which Applicants attribute the feature. Therefore, the Examiner should take the feature as part of the overall claimed invention of which it is a part, and give it appropriate weight.

Second, contrary to the Examiner's position, Applicants have indicated that giving priority to a system controller, which in some claims is connected to memory over a first bridge, is an aspect of the invention. *See, e.g.*, specification pp. 5-6, para. 21. Specifically, what the arbiter does is to give priority to the system controller when both the controller and the EEPROMs want to access the shadow RAM at the same time.

The Examiner's stated rationale (Office Action, p. 6) for giving priority to the first signal path amounts to little more than taking judicial notice. Accordingly, if the Examiner is going to maintain his position, Applicants respectfully request that the Examiner cite a reference to support that position.

Neither Fujimori, nor Huang, nor any combination of the two, remedies the foregoing deficiencies in Sefidvash. Consequently, Applicants submit that independent claims 1, 16, and 31, and their corresponding dependencies, are patentable.

Finally, Applicants note that independent claims 1, 16, and 31, which the Examiner found originally to be generic to all of the species, still are generic, and accordingly Applicants respectfully request that the Examiner allow the withdrawn species claims as well.

Request for Allowance

It is believed that this Amendment places the application in condition for allowance, and early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the telephone number listed below.

The Office is hereby authorized to charge any fees, or credit any overpayments, to Deposit Account No. **11-0600**.

Respectfully submitted,
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